

REMARKS

Claims 1 and 19 are independent and stand rejected under 35 U.S.C. § 102 as being anticipated by newly cited Ooyama et al. '494 ("Ooyama"). This rejection is respectfully traversed for the following reasons.

Claim 1 recites in pertinent part, "the lead completely filling the groove portion" In contrast, the alleged lead 28 of Ooyama simply lines the bottom/side surfaces of the alleged groove portion 33b as shown in Figure 5E of Ooyama without sufficient thickness to fill the groove portion.

Claim 19 recites in pertinent part, "the first conductor layer covering an entire surface of said portion and including a part within an enclosed groove of the piece of sealing resin." In contrast, the alleged "first conductor layer" 28a reaches only the outer, bottom surface of the alleged sealing resin 23 as shown in Figure 5H of Ooyama.

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that Ooyama does not anticipate the independent claims, nor any claim dependent thereon.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as the independent claims are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are

Application No.: 10/757,388

also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination. In this regard, it is respectfully requested that the withdrawn claims which are dependent, directly or indirectly, on claims 1 and 19 be rejoined as being dependent on an allowable claim.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 102 be withdrawn.

CONCLUSION

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below. To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Ramyar M. Farid
Registration No. 46,692

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 RMF:men
Facsimile: 202.756.8087
Date: November 6, 2006

**Please recognize our Customer No. 20277
as our correspondence address.**